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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,188	12/09/2005	Serge Tetart	264665US0PCT	1490
22850	7590	12/04/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
12/04/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/522,188

Applicant(s)

TETART, SERGE

Examiner

Patrick D. Niland

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 15, 17-19, and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15, 17-19 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/18/08 has been entered.

The amendment of 9/18/08 has been entered. Claims 1-9, 15, 17-19, and 22-25 are pending.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 18-19, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5270434 Tetart et al. in view of US Pat. No. 6395819 Espiard et al. and WO 01/23655 Zeng et al..

Tetart discloses the instantly claimed sizing composition and insulation products made therefrom. It is noted that the excess of formaldehyde of Tetart, column 6, lines 41-44 falls within the scope of the instantly claimed crosslinking agent of claims 1, 18, 19 according to page 7 line 25 of the instant specification with the "gel" reference of column 6, lines 44-48 indicating that crosslinking actually occurs during sizing. See the abstract; column 1, lines 1-68, particularly 12-15, 20-22, and 25-44 of which 38-44 indicates crosslinking of the size; column 2, lines 1-68, particularly 10-13; column 3, lines 1-68, particularly 44-68; column 4, lines 1-68, particularly 1-2 which fall within the scope of the instantly claimed aminoalcohols of claims 1, 3, 5, lines 3-19; column 6, lines 1-68, particularly 33-44; and the remainder of the document.

“Comprising” of the instant claims encompasses extra steps and/or ingredients of the references. Column 6, lines 53-59 fall within the scope of the instant claim 25.

The patentee is silent regarding the specific structure of the disclosed “insulating products” of column 6, line 36. Since the instant applicant is a coinventor of the Tetart et al. patent, the examiner asks for information regarding what these “insulating products” were intended to be in terms of their structure. In other words were the structures of these “insulating products” intended to be the same as the structures of the insulating products of the instant claims? See 37 CFR 1.56.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed sizing composition on insulating products having the instantly claimed structures because such structures are known as taught by Espiard et al., abstract; column 8, lines 32-39, which includes the instantly claimed densities of claim 1 and Zeng et al., abstract, Figure 1, page 4, lines 7-11 of which the scrim is taken as falling within the scope of the tissue mat of article number 3 of claim 1, these articles may be of sized fibers and they would have been expected to benefit from the properties of the sizing of Tetart et al. for the reasons disclosed in Tetart et al. in its entirety.

The instant claims are directed to products per se. The new recitation of “simultaneously” regarding the method of making the resin is noted. However, it is not seen that the product of this method is different than the product of Tetart. It is noted that the phenol ratio of column 4, lines 29-33 allows for excess phenol to remain to react with the aminoalcohol, which would appear to give the same or similar product as the instantly claimed method. The PTO has to experimental facilities to make such determinations. The burden is therefore on the applicant to

show that the method of the instant product claims gives a different product than the method of Tetart and an unobvious difference. See MPEP 2112-2113. The applicant's arguments in this regard are noted but there is no probative evidence that the products of the instant claims are different than those discussed above due to the newly recited method of making the resin, particularly considering the phenol ratios of Tetart. It is noted that Tetart has low residual contents of formaldehyde and the same water dilutability as the instantly claimed resins and thus appears to give the same product as the instant claims. It is further noted that the instant claims do not recite sufficient reaction parameters, such as reaction time, temperature, pressure, etc., nor any amount of free reactants to support the applicant's representatives remarks, which are unsupported by probative evidence, regarding any differences due to "simultaneous" reaction. Arguments regarding the reaction of the cited prior art not accounting for the instantly claimed simultaneous reaction and the reasons that no evidence is needed to show that the products of the cited prior art are different than those of the instant claims are noted. The instant claims do not recite amounts of amine and therefore encompass the amounts of phenol formaldehyde and phenol formaldehyde amino resins argued by the applicant since both the instant claims and the references read on stoichiometric amounts of reactants to give such resin amounts. Furthermore, the applicant has not demonstrated that the Mannich base does not react with the phenol formaldehyde resin at all. It is noted that chemistry is an unpredictable art. The examiner recalls undergraduate organic chemistry in which typical yields of theoretical products were about 60% with the remainder being side reactions. Given that the instantly claimed reactions and the prior art reactions are expected to yield numerous different products by the nature of polymer chemistry evidenced minimally by average molecular weights of polymers, average

functionalities of monomers, monomer amount and distribution differences per molecule of a given polymer sample, etc., it is expected that the instant claims overlap with the products of the cited prior art considering the lack of experimental parameters of the instant claims, as noted above. MPEP 2114 is noted. The claimed features were all given proper consideration. Note again MPEP 2112-2113 regarding the simultaneous reaction of the instant claims verses the reaction of the cited prior art and the above discussions in relation thereto. No probative evidence is seen that the instant claims do not encompass the reaction product of the cited prior art for the reasons stated above. For the above reasons, this rejection is maintained.

4. Claim 15 is allowable for reasons of record.

5. Claim 17 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. The prior art of record does not disclose the instantly claimed invention nor provide rationale for using the limitations of claim 17.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1796

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796